

REMARKS

The application was filed on 30 March 2001 with twelve claims. In the first examination of the application mailed 24 March 2005, claims 5, 6, 8, 9, and 12 were rejected under 35 U.S.C. §112, second paragraph. Claims 1 and 4 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,765,138 entitled APPARATUS AND METHOD FOR PROVIDING INTERACTIVE EVALUATION OF POTENTIAL VENDORS to Aycock et al. (Aycock '138); claims 2, 3, 7-11 were rejected under 35 USC. §103(a) as being unpatentable over Aycock '138; and claims 5, 6 and 12 were rejected under 35 U.S.C. §103(a) over Aycock '138 in view of U.S. Patent No. 5,627,973 entitled METHOD AND APPARATUS FOR FACILITATING EVALUATION OF BUSINESS OPPORTUNITIES FOR SUPPLYING GOODS AND/OR SERVICES TO POTENTIAL CUSTOMERS to Armstrong (Armstrong '973). Applicants amended the claims, cancelled claims 10-12 and added claims 13-20.

The Patent Office responded on 07 October 2005 by maintaining the rejection of claims 6 and 9 under 35 U.S.C. §112, 2d paragraph. New rejections of claims 1-9 and 13-20 under 35 U.S.C. §112, first and second paragraphs were set forth. Claims 1-9 and 13-20 were newly rejected under 35 U.S.C. §101 alleging that the invention is directed to non-statutory subject matter, asserting that the claimed invention does not produce a useful, concrete, and tangible result. Applicants amended claims 1, 6, 7, and 9, and removed an abbreviation from the other claims.

The Patent Office responded with yet another Action mailed 03 April 2006, rejecting claims 1-9, 13-20 under 35 U.S.C. §112, first and second paragraphs. The rejection of the claims under 35 U.S.C. §101 was maintained stating that the claimed invention does not produce a useful, concrete, and tangible result, are pending. The Examiner further rejected claims 1-9 and 13-20 under 35 U.S.C. §103(a) as being unpatentable over Daskalontonakis, Michael K., "ACHIEVING HIGHER SEI LEVELS" IEEE COMPUTER, Vol. 27, No. 7, pp. 17-24, July 1994 (hereinafter referred to as Daskalontonakis) and Paulk, Market al., "Capability Maturity Model for Software, Version 1.3, Technical Report CMU/SEI-93-TR-024" SOFTWARE ENGINEERING INSTITUTE, Carnegie Mellon University, Pittsburgh, Pennsylvania, February 1993 (hereinafter referred to as CMM). Applicants amended the claims and cancelled claim 20.

The Examiner then issued a final rejection of the claims in a detailed action mailed 25

September 2006. The Examiner objected to claim 15, and further rejected claims 1-6 under 35 U.S.C. §112, second paragraph. The Examiner maintained the rejection of claims 1-4, 6-9, 13-19 under 35 U.S.C. §102(b) as being anticipated by CMM. The Examiner also rejected claim 5 as being obvious over CMM. Applicants filed a Request for Continued Examination with a supplemental amendment in which claims 13 and 19 were canceled, claims 21 and 22 were added, and claim 5 was rewritten as claim 23.

The claims are rejected yet again. Claims 1-6 are rejected under 35 U.S.C. §112, first paragraph and 35 U.S.C. §101. The rejections of claims 1-9, 14-18 and 31-23 under 35 U.S.C. §103(a) over CMM and Daskalantonakis is maintained. Claims 2, 6 and 23 are amended. Claims 1-9, 14-18, 21-23 are pending.

The Rejection of claims 1-6 under 35 U.S.C. § 112, first paragraph

Claims 1-6 are rejected under 35 U.S.C. §112, first paragraph as failing to comply with the enablement requirement. The specification allegedly fails to enable one skilled in the art to identify any disparity between the expectation of the information technology organization delivering the information technology services and the expectations of the external customers using the serves; it is not clear how this disparity is found. Applicants disagree.

Claim 1 explicitly states that the disparities between the expectations of the IT organization and the external customers are identified by evaluating the answers to the questions and the maturity of the respective organization. One of skill in the art understands the specification at page 10 lines 17-19 to provide that “[o]ne focus in this process is to determine whether the provider and the customer have a common understanding of the scope and objective of the IT services being provided and to identify any disparity between the expectations.” How is this done? The specification at page 11 lines 12-14 teaches that “[o]ne key aspect to assessing a service is to note the gap between the reality and the perceptions as seen by the customer and by the provider” and further provides that “as the organization moves to the right in Fig. 3 it is increasing customer satisfaction, **moving from meeting customer expectations in the middle to exceeding customer expectations at the right (and falling short of customer expectations to the left)**—“ (emphasis added). Figure 5 also enables one of skill in the art to identify any disparity between the expectations of the IT organization delivering the IT services and the expectations of the external customer using the services: as a service attribute achieves greater

maturity, the disparity between the expectations of the customer and the IT organization becomes less. For example, when the definition of service is immature or at the ad hoc level, there is no agreement or understanding of a service provided by the IT organization or the purpose of the service, i.e., there is a significant disparity of the expectations; on the other hand, when the definition of service is mature, both the IT organization and the customer understand and promote the service and the mission of the service is consistent with the IT and the business view of the contribution and role of the service. Another example to consider is the how to determine if a service achieves results. A significant disparity exists at the adhoc maturity level, when there are no reports or available data to indicate the results or if there is evidence of poor results whereas when the disparity between the expectations of the IT organization and the customer is minimal or nonexistent as in a world class mature service, both the IT organization and the customer recognize that the service is exceeding its objectives in all aspects, measurements are continuing being revised and the bar is being raised; feedback is provided on each component of service delivery; the cycle time is reduced. There is adequate teaching in the specification of how to identify the disparities in the expectations between the customer and the IT organization. Applicants request the rejection of claims 1-6 under 35 U.S.C. §112, first paragraph be withdrawn.

The Rejection of claims 1-6 under 35 U.S.C. § 101

With respect to the rejection under 35 U.S.C. §101, the rejection states that the invention does not produce a concrete result. Applicants traverse the rejection. To satisfy the requirements of 35 U.S.C. §101, an applicant must claim show that the claimed invention is “useful” for some purpose either explicitly or implicitly. Thus, the proper inquiry is whether the claimed invention is useful, i.e., has applicant set forth a specific and substantial utility? Yet, the rejection requires the Applicants to answer, “does the ‘IT organization perform it’s own evaluation which is then compared to the external customer’s perception? What is the customer’s evaluation compared to?” The rejection further states that process must have a result that can be substantially repeatable or the process must substantially produce the same result again. Respectfully, this is not the proper inquiry. Whenever an evaluative process occurs, the results may differ depending upon the answers to the questions and the focus area of the service attribute. Applicants are not claiming that the results of the claimed evaluative method are the

same each time the method is administered, rather Applicants claim a method to evaluate satisfaction and value of IT services whose steps and methodology are repeatable. Applicants direct the Patent Office's attention again to the specification at page 10 lines 17-19 whereby one of ordinary skill in the art will appreciate the usefulness of the claimed invention to determine "whether the provider and the customer have a common understanding of the scope and objective of the IT service being provided and to identify any disparity between the expectations." See MPEP 2107.02(II.A); *see also* page 12 of Applicants' Amendment Under 37 CFR 1.111 mailed on 09 January 2006, and pages 13-15 of Applicants' Amendment Under 37 CFR 1.111 mailed 03 July 2006 for more examples of the useful, concrete and tangible results of the claimed invention. In fact, Applicants have repeatably shown the practical utility of the claimed invention, and Applicants request that the rejection of the claims 1-6 under 35 U.S.C. §101 be withdrawn.

The Rejection of claims 1-9, 14-18, and 21-23 under 35 U.S.C. § 103(a)

The pending claims were rejected as being obvious over CMM and Daskalantonakis. The rejection states that claimed attributes are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The rejection goes on to say that the cited method steps would be performed the same regardless of the specific data, and that the descriptive material will not distinguish the claimed invention. Applicants respectfully traverse the rejection.

The claim limitations of the focus areas and service attributes are not merely descriptive material, but are functionally involved in the method steps recited. Independent claims 1 and 7 specifically state that the method comprises, *inter alia*, evaluating five attributes. These five attributes are not merely descriptive material but rather determine the scope of the claimed subject matter. Neither the CMM nor the Daskalantonakis reference, moreover, suggest or teach using these five attributes to identify disparities of the IT services provided as perceived by the provider of the service or the customer of the service. None of these five attributes of the claimed methodology are mentioned by either reference. Functional limitations of the scope of the set of questions are not mere data; the attributes define are actual limitations on the acts being performed by the claimed method. See MPEP 2106.01 wherein descriptive material consists of

data structures and computer programs, or of music literary works or compilation or mere arrangement of data.

Respectfully, Applicants assert that neither reference teaches or suggest a method of evaluating the satisfaction nor value of IT services by evaluating the claimed five attributes. Applicants request the Examiner withdraw the rejection under 35 U.S.C. §103(a).

Conclusion

This long pending application has been the subject of at least three different rejections under 35 U.S.C. §101 – all of which have been overcome; has been the subject of numerous rejections under 35 U.S.C. §§102 and 103 – all of which have been traversed. Applicants are entitled to a patent on the novel and nonobvious method of evaluating the satisfaction and value of IT services using the five attributes as claimed. The Examiner is requested to telephone the attorney below if it would expedite issuance and allowance of the case.

Please charge any additional fees or credit overpayment to Deposit Account No. 09-0457.



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Respectfully submitted,

HAMRE, SCHUMANN, MUELLER &
LARSON, P.C.
P.O. Box 2902
Minneapolis, MN 55402-0902
(612) 455-3800

By: 

Karuna Ojanen
Reg. No. 32484
KO/ls